

**REMARKS**

Claims 1-36 constitute the pending claims in the present application, and claims 1, 2, 5, 6, 9, 10, 13-17, 21-25, 30, 32, 34, and 37-46 are currently under consideration. Claims 1, 5, 9, 37, and 39 have been amended to delete explicit reference to the route of administration of the anti-hedgehog antibodies. Applicants' amendments are supported by the previously pending claims. Specifically, prior to Applicants' amendments filed March 20, 2006, the claims did not require topical administration. Applicants add new claims 47-49. Support for the subject matter of these claims is found throughout the application. No new matter has been entered. Specific support can be found, for example, in paragraph [0059] of the application, as published.

Applicants request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the previous office action.

1. Applicants note with appreciation that the amendments put forth on March 22, 2006 have been entered in full.
2. Applicants note with appreciation that any objections or rejections that were not expressly maintained in this Office Action have been withdrawn.
3. Claims 1, 2, 5, 6, 9, 10, 13-17, 21-25, 30, 32, 34, and 37-46 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over US Patent No. 6,639,051 (the "'051 patent") in view of Ericson et al. and US Patent No. 4,816,567 (the "'567 patent"). Applicants traverse this rejection and contend that the rejection is moot in light of the amended claims.

Applicants maintain the arguments of record and contend that the combination of references fail to satisfy the criteria necessary for rendering the claimed invention obvious. Additionally, however, Applicants submit that the '051 patent is not available as prior art against the present application under 35 U.S.C. 103(a). Absent the teachings of the '051 patent, the cited references fail to teach or suggest the claimed invention, and thus fail to undermine the patentability of the claimed invention.

The basis for Applicants' contention that the '051 patent is not available as prior art against the present application is detailed in MPEP 706.02(I). Specifically, "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections

(e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section [section 103(a)] where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." MPEP 706.02(l) further explains that "[f]or purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if - (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made; (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement."

Applicants note that the '051 patent qualifies as prior art only under 35 U.S.C. 102(e). Consistent with 35 U.S.C. 103(a) and with the provisions of the Cooperative Research and Technology Enhancement Act (CREATE Act), Applicants contend that the '051 patent is not available as prior art against the present application.

Applicants note that the subject matter of the present application (Application Serial Number 09/804,490) and US Patent No. 6,639,051 were made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement. The joint research agreement was between Curis, Inc. and Biogen, Inc. Consistent with the provisions of the CREATE Act, Applicants have amended the specification to name the parties to the joint research agreement. 37 C.F.R. 1.71(g)(1). Furthermore, Applicants authorize payment of the appropriate fee. 37 C.F.R. 1.17(i).

Applicants' statement and amendment to the specification are believed to comply with the safe harbor provisions of 35 U.S.C. 103(a) and the CREATE Act, and are believed to preclude rejection of the presently claimed invention under 35 U.S.C. 103(a) based on the '051 patent. Reconsideration and withdrawal of this rejection is respectfully requested.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Please charge any further fees due or credit any overpayments to **Deposit Account No. 18-1945, under order no. CIBT-P01-114.**

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Respectfully Submitted,



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